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REMARKS/ARGUMENTS

Claims 5-14 are pending in this application. By this Amendment, Applicants cancel claims 15-19.

Claims 15-19 have been canceled since these claims are directed to a non-elected invention. Applicants reserve the right to file a Divisional Application in order to pursue prosecution of non-elected Claims 15-19.

Non-elected Claim 13 is dependent upon generic Claim 5. Accordingly, Applicants respectfully request that the Examiner rejoin and allow Claim 13 when Claim 5 is allowed.

Applicants appreciate the Examiner's indication that Claims 6-8, 11 and 12 would be allowable if rewritten in independent form including all of the features of the base claim and any intervening claims.

Claims 5, 9, 10, and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Applicants' Admitted Prior Art Fig. 11 (AAPA). Applicants respectfully traverse the rejection of Claims 5, 9, 10, and 14.

Claim 5 recites:

A laminated coil component comprising:
a coil conductor including a plurality of strip electrodes and via-holes for connecting predetermined ends of the strip electrodes inside a ceramic laminate; wherein

an axis of the coil conductor corresponds with a width direction of the ceramic laminate, which is substantially perpendicular to both a thickness direction and a length direction of the ceramic laminate. (emphasis added)

With the unique combination and arrangement of features recited in Applicants' Claim 5, including the feature of "an axis of the coil conductor corresponds with a width direction of the ceramic laminate, which is substantially perpendicular to both a thickness direction and a length direction of the ceramic laminate," Applicants have been able to provide a laminated coil component which achieves a high relative inductance (L) by equalizing the inner area and the outer area of a coil conductor, while

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maintaining a reduced size and a thin shape, and which effectively prevents a decrease in insulating resistance between via-holes (see, for example, the last full paragraph on page 4 of the Substitute Specification).

The Examiner alleged that AAPA teaches all of the features recited in Claim 5, except for the specific axis arrangement of the coil conductor. The Examiner further alleged that it would have been obvious “to arrange the coil conductor axis in the ceramic’s width direction instead of length direction, since it has been held that a mere reversal/re-arrange[ment] of the essential working parts of a device involves only routine skill in the art.” Applicants respectfully disagree.

First, the Examiner relied upon *In re Einstein*, 8 USPQ 167, to allegedly support his argument. However, *In re Einstein* specifically holds that the only time that a reversal or re-arrangement of the essential working parts would have been obvious, as alleged by the Examiner, is when such a reversal or re-arrangement of parts would not change the operation of a device and would not produce different results (see the third and fourth paragraphs of the OPINION section of *In re Einstein*). As specifically disclosed in the present application, the laminated coil component including the specific axis arrangement of the coil conductor recited in Applicants’ Claim 5 produces very different results than the laminated coil component of AAPA. For example, the laminated coil component recited in Applicants’ Claim 5 has a much higher relative inductance than the laminated coil component of AAPA.

Thus, Applicants’ respectfully submit that it would not have been obvious to arrange the coil conductor axis of AAPA so as to correspond with a width direction of the ceramic laminate, which is substantially perpendicular to both a thickness direction and a length direction of the ceramic laminate as recited in Applicants’ Claim 5.

Second, MPEP 2144 specifically sets forth that it is not appropriate to rely solely on case law as the rational to support an obviousness rejection, if Applicants have demonstrated the criticality of a specific limitation. *In re Eli Lilly & Co.*, 902 F.2d 943 (Fed. Cir. 1990). In the present application, Applicants have clearly demonstrated the

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criticality of the feature of “an axis of the coil conductor corresponds with a width direction of the ceramic laminate, which is substantially perpendicular to both a thickness direction and a length direction of the ceramic laminate” as recited in Applicants’ Claim 5, i.e., to provide a laminated coil component which achieves a high relative inductance (L) by equalizing the inner area and the outer area of a coil conductor, while maintaining a reduced size and a thin shape, and which effectively prevents a decrease in insulating resistance between via-holes.

Thus, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness in the rejection of Claim 5 over AAPA.

Third, the PTO has the burden under 35 U.S.C. §103 to establish a *prima facie* case of obviousness. See *In re Piasecki*, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). The PTO can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. See *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1984). This it has not done. The Examiner failed to cite prior art that remedies the deficiencies of AAPA or that suggests the obviousness of modifying AAPA to achieve Applicant’s claimed invention.

Instead, the Examiner improperly relied upon hindsight reconstruction of the claimed invention in reaching his obviousness determination. To imbue one of ordinary skill in the art with knowledge of the invention, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher. *W.L. Gore & Assoc. v. Garlock, Inc.*, 721 F.2d 1540, 1543, 220 USPQ 303, 312-13 (Fed. Cir. 1983).

The Examiner is reminded that prior art rejections must be based on evidence. *Graham v. John Deere Co.*, 383 U.S. 117 (1966). The Examiner is hereby requested to cite a reference in support of his position that it was well known at the time of

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Applicants' invention to arrange a coil conductor such that "an axis of the coil conductor corresponds with a width direction of the ceramic laminate, which is substantially perpendicular to both a thickness direction and a length direction of the ceramic laminate". If the rejection is based on facts within the personal knowledge of the Examiner, the data should be supported as specifically as possible and the rejection must be supported by an affidavit from the Examiner, which would be subject to contradiction or explanation by affidavit of Applicants or other persons. See 37 C.F.R. § 1.104(d)(2).

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of Claim 5 under 35 U.S.C. § 103(a) as being unpatentable over AAPA.

In view of the foregoing amendments and remarks, Applicants respectfully submit that Claim 5 is allowable. Claims 6-12 and 14 depend upon Claim 5, and are therefore allowable for at least the reasons that Claim 5 is allowable. In addition, Applicants respectfully request that the Examiner rejoin and allow non-elected Claim 13.

In view of the foregoing amendments and remarks, Applicants respectfully submit that this application is in condition for allowance. Favorable consideration and prompt allowance are solicited.

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The Commissioner is authorized to charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-1353.

Respectfully submitted,

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